

Remarks

After amendment, claims 1, 3-8, 22 and 32-34 are pending in the present application. Claims 2, 9-21 and 23-31 are cancelled. Claim 2 has been incorporated into newly amend claim 1, which has been amended *without prejudice* pursuant to the Examiner's restriction requirement. The remaining claims are cancelled *without prejudice* as being directed to non-elected species and/or invention groups. Claims 32-34 are newly added. Support for the amended claims may be found throughout the originally filed specification and claims and in particular in the specification at pages 23-24. No new matter has been added by way of this amendment.

The Examiner has rejected or objected to the originally filed claims as being directed to non-elected subject matter or variously under 35 U.S.C. §112, first paragraph and §102(b) over the cited reference Yamazaki, et al.. For the reasons which are presented in the sections which follow, it is respectfully submitted that the instant application is now in condition for allowance and such action is earnestly solicited.

The Objection to the Claims

The Examiner has objected to a number of claims as being directed to non-elected subject matter. Applicants have cancelled *without prejudice* claims which are directed to non-elected subject matter as well as subject matter in claims 1 and 22. Applicants respectfully submit that the instant amendment completely addresses the Examiner's objection to the claims. It is noted that Applicants will give consideration to filing a divisional application directed to the cancelled subject matter at a later time. Regarding the objection to claim 7-10 and 12 (multiple dependency), Applicants have amended claim 7 to refer to claims 5 or 6 in the alternative and cancelled claims 9-12, thus obviating any objection to those claims. It is respectfully submitted that Applicants have cogently addressed the Examiner's objections to the claims.

The §112, First Paragraph Rejection

The Examiner rejected the originally presented claims as being non-enabled for the reasons which are set forth in the office action. That original rejection was based upon the breadth of claim 1, which has been amended for reasons related to the restriction requirement. It is respectfully submitted that the presently claimed methods are enabled. This is based upon the working examples which are presented in the specification, the general description provided therein, as well as the body of information which relates to synthetic organic chemistry that the person of ordinary skill will rely on in practicing the claimed invention.

Regarding the Examiner's argument that the instant claims are non-enabled because there has been no showing that the particular intermediates can be used in synthetic approaches to cephalostatins and ritterzines, Applicants can only submit that this rejection is perhaps more aptly considered a rejection that the present invention has no utility. The present invention relates to a method for oxidizing a tertiary carbon in a hydrocarbon of claimed structure to produce the claimed hemiacetal. Thus, the method generally exhibits utility in that the hemiacetal may be used (as a large number of other chemical compounds may be used) to produce cephalostatins and ritterzines. Utility is established unless the Examiner can posit information in the form of articles, publications, etc., which make that utility suspect. In the present application, the utility is readily apparent and is credible. See M.P.E.P. §2107 II. Note that Applicants are not claiming a method to make cephalostatin and/or ritterzines, only that the method can be used to produce the claimed hemiacetal. The invention is the method, not the claimed hemiacetal. The hemiacetal which is produced, can be modified (in a number of steps) to produce cephalostatins and/or ritterzines. It is respectfully submitted that the present invention is enabled and that a credible utility has been established.

The §102 Rejection

The Examiner has rejected claims 1, 2, 9 and 12 under 35 U.S.C. 102(b) as being anticipated by Yamazaki, et al. Inasmuch as the instantly claimed invention has been substantially narrowed from the originally filed application in order to limit the claims to the elected species as requested by the Examiner, it is respectfully submitted that this rejection has been rendered moot. Yamazaki, et al. does not disclose or suggest the instantly claimed invention.

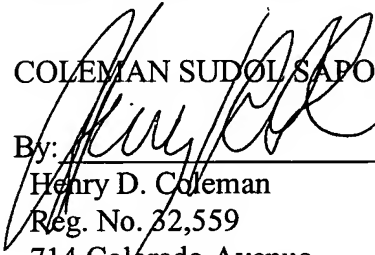
For the above reasons, Applicant respectfully asserts that the claims set forth in the present amendment are now in compliance with 35 U.S.C. Applicants respectfully submit that the present application is now in condition for allowance and such action is earnestly solicited.

Applicant has cancelled 23 claims and added three claims (non independent). No fee is therefore due for the presentation of this amendment. A petition for a one month extension of time is enclosed. A check for the appropriate fee is enclosed. Small entity status is claimed for the present application.

Please credit any overpayment or charge any additional fee due to Deposit Account No.
04-0838.

Respectfully submitted,

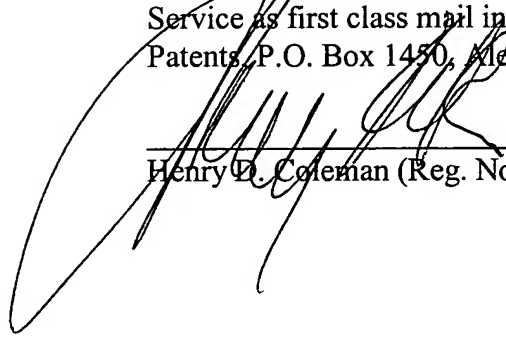
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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on May 17, 2006.


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